

REMARKS

These remarks are responsive to the final Office Action of December 2, 2004. Claims 1, 6, 7, 11, 13, 20, 23 and 24 have been editorially amended for issuance. Claims 1-20 and 23-24 are pending. No new matter has been added. Applicant respectfully requests reconsideration and allowance of the instant application.

Independent Claims 1, 13, and 20

The Office Action rejected claims 1-4, 6-10, 13-16 and 19-20 under 35 U.S.C. § 103(a) under a combination of Leman (U.S. Patent No. 6,288,706) and Solhjell (U.S. Patent No. 5,621,436).

Independent claims 1 and 20 pertain to, *inter alia*, an inventive computer keyboard comprising a first input device configured to receive manual movement according to a first user-selectable mode and responsive thereto, configured for scrolling content items of a display screen relative to the display screen along perpendicular axes direction so as to change movement of said content items along one of the perpendicular axes based on a predetermined elapsed time, and second user selectable mode for freeform moving a graphical pointer relative to the perpendicular axes. Neither Leman nor Solhjell, separately or in combination, teach or suggest the recited features. For example, Leman is devoid of describing scrolling or an input device for scrolling as recited in claims 1 and 20. In fact, Leman's device embodiments 80, 280, 480, 483 and 583 are merely limited to just pointing devices. (See Col. 4, ll. 53-61.) There is no first input device configured for scrolling content items and graphical pointing as recited. Leman simply does not teach or suggest a scrolling function for moving content items of the display screen relative to the display screen along perpendicular axes as recited.

Solhjell completely fails to make up for the deficiencies in Leman. Solhjell is devoid of describing scrolling or an input device configured for scrolling as recited in claims 1 and 20. There is nothing about scrolling described in Solhjell's embodiments or background discussion of Solhjell. Solhjell's embodiments are limited to mouse balls 24, 35 as pointing devices. Nowhere does Solhjell teach or suggest a device configured to receive manual movement and responsive thereto, configured according to a first user-selectable mode for scrolling content items of a display screen relative to the display screen changing movement based on a

predetermined elapsed time and a second user selectable mode moving a graphical pointer as recited in claims 1 and 20. In view of the foregoing, independent claims 1 and 20 are allowable and the respective claims depending therefrom.

Independent claim 13 pertains to, *inter alia*, a computer keyboard comprising a trackball device having a movable ball within an opening and a movable ball being configured to receive manual movement according to a first user-selectable mode and responsive thereto configured for scrolling content items of a display screen relative to the display screen in a vertical direction and a horizontal direction so as to change movement of said content items along one of the vertical and horizontal direction based on a predetermined elapsed time, and a second user selectable mode for freeform moving a graphical pointer relative to two dimensions of the image display screen. Leman does not teach or suggest the trackball device as recited. In fact, Leman merely refers to element 80 as a pointing device. (See Col. 3, ll. 24-55; *see also* Col. 5, ll. 1-15). It is clear that Leman's pointing device embodiments (e.g., device 80) simply do not describe the user-selectable modes for scrolling for a trackball device and graphical pointing as recited. In view of the foregoing, claim 13 is allowable and the respective claims depending therefrom.

Dependent Claims

Claims 2-4 and 6-12 depend from claim 1 and are thus allowable for at least the same reasons as claim 1 and further in view of the novel and non-obvious features recited therein. For example, with further reference to claims 2-4, neither Leman, nor Solhjell, alone or in combination, describe or suggests a computer keyboard with a trackball assembly including a spherical member being rotatably configured to receive manual movement for scrolling as recited. With respect to claims 2 and 3, Solhjell is completely devoid of any mention, teaching or suggestion of a scrolling sensing system that determines when said spherical member is rotated for scrolling along one of the perpendicular axes as is recited. The Office Action asserts that Col. 2, ll. 7-26 of Solhjell teaches a scrolling sensing system. On the contrary, Solhjell merely describes an internal mouse control for ball movement and cursor movement. (See Col. 2, ll. 7-26). There is absolutely no a description of a scroll sensing system, nor the recited scroll sensing system for a trackball device with the user-selectable mode configuration for scrolling or graphical pointer control. In view of the foregoing, claims 2 and 3 are allowable.

Claim 3 pertains to, *inter alia*, a keyboard with the recited trackball assembly comprising a scrolling sensing system being configured to sense a transition state of the spherical member when the member is rotated for a first directional scrolling along one of the perpendicular axes and responsive to the transition state change to a second directional scrolling along the other of the perpendicular axes. There is no scrolling or scroll sensing system as discussed with respect to claim 2. Further, Solhjell is completely **devoid** of any such suggestion or mention of 1) scrolling along perpendicular axes, 2) a transition state of a spherical member for scrolling, much less 3) sensing a transition state of the spherical member when the member is rotated for a first directional scrolling along one of the perpendicular axes and 4) responsive to the transition state change to a second directional scrolling along the other of the perpendicular axes. In view of the foregoing, claim 3 is allowable.

Further with respect to claims 2-4, the Office Action recognizes that Leman fails to teach or suggest a scroll sensing system as recited. (See Office Action, Pg. 3.) In fact, Leman and Solhjell both fail to teach a first input device or trackball device configured for scrolling as recited. The references are simply limited to solely pointing devices. There is no scroll sensing system. Further, Applicant submits that the combination of the Leman and Solhjell is not legally proper. There is no supported motivation to combine the references. As clearly held by the U.S. Court of Appeals for the Federal Circuit, “[i]t is impermissible to use the claimed invention as an *instruction manual* or “*template*” to piece together the teaching of the prior art ... [o]ne cannot use hindsight construction to pick and choose among isolated disclosures ... to deprecate the claimed invention.” *In re Fritch*, 972 F.2d 1260, 1266 (quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988) (emphasis added)).

In further reference to claim 7, neither Leman, nor Solhjell describe or suggest a first input device comprising a scroll wheel assembly configured to receive manual movement according to a user-selectable mode and responsive thereto, configured for scrolling content items of a display screen relative to the display screen along perpendicular axes or freeform moving a graphical pointer relative to the perpendicular axes. The Office Action asserts that device element 583 of Leman comprises a scroll wheel assembly. (Office Action Pg. 4). On the contrary, according to Leman, device element 583 merely indicates a thumbwheel for a “pointing device”. (See Col. 6, ll. 65-67 below). Leman is completely **devoid** of any teaching or

suggestion that the thumbwheel is a scroll wheel assembly or performs the function of scrolling as recited. Solhjell's embodiments fail to cure the deficiencies of Leman. In view of the foregoing, claim 7 is allowable for this reason as well.

Claims 14-16, 19, 20 and 23 depend from claim 13 and are thus allowable for at least the same reasons as claim 13 and further in view of the novel and non-obvious features recited therein.

Claims 15 and 16, similar to claims 2 and 3, respectively, pertain to, *inter alia*, a trackball assembly including a spherical member being rotatably configured to receive manual movement and a scrolling sensing system. As discussed previously, neither Leman, nor Solhjell teach or suggest such an inventive feature. Further there is no motivation to combine such references. In view of the foregoing, claims 15 and 16 are allowable.

Claim 24 depends from claim 20 and is thus allowable for at least the same reasons as claim 20 and further in view of the novel and non-obvious features recited therein.

The Office Action rejected claims 5 and 17-18 under 35 U.S.C. §103(a) under the combination of Leman and Solhjell as applied to claims 1-4, 6-10, 13-16 and 19-20 and further in view of U.S. Pat. No. 4,720,703 to Schnarel.

The Office Action recognizes that neither Leman, nor Solhjell teach or suggest a scrolling sensing system that determines when the spherical member is rotated for directional scrolling along one of the perpendicular axes to a threshold level after a transition state of the directional scrolling so as to maintain said scrolling. In fact, Leman and Solhjell fail to teach or suggest the recited keyboards with the first input device (claim 1) and the trackball device (claim 13) as discussed in the foregoing. Schnarel fails to cure the deficiencies of the Leman and Solhjell combination. Schnarel's embodiments do not describe scrolling for the first input device and trackball device as recited. The passage cited in the Office Action at p. 7 merely describes moving a viewport in the direction of cursor movement. (Col. 4, ll. 19-28).

The mere fact that Schnarel discusses a movable viewport has **no** bearing on 1) the recited scrolling of content items of a display screen relative to the display screen, 2) the recited scroll sensing system, or 3) the recited transition state for a spherical member. The legal standard of obviousness requires that "particular findings must be made as to the reason the

skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the matter claimed.” *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000) (emphasis added). As clearly held by the U.S. Court of Appeals for the Federal Circuit, “[i]t is impermissible to use the claimed invention as an *instruction manual or “template” to piece together* the teaching of the prior art ... [o]ne cannot use hindsight construction to pick and choose among isolated disclosures ... to deprecate the claimed invention.” *In re Fritch*, 972 F.2d 1260, 1266 (quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988) (emphasis added)). This is especially true, when Schnarel has **no specific description** of claim 5, e.g., 1) a scrolling sensing system that 2) determines when the spherical member is rotated for directional scrolling 3) along one of the perpendicular axes to 4) a threshold level 5) after a transition state of the directional scrolling 5) so as to maintain said scrolling.

Further, Schnarel has no specific description of claim 17, e.g., the trackball device further including 1) a scrolling sensing system that 2) determines when the movable ball is rotated for vertical scrolling to 3) a threshold parameter 4) after a transition state of the horizontal scrolling 5) so as to maintain said vertical scrolling. Further, there is no motivation to combine the references.

Furthermore, Schnarel has no specific description of claim 18, e.g., the trackball device further including 1) a scrolling sensing system that 2) determines when the movable ball is rotated for horizontal scrolling to 3) a threshold parameter 4) after a transition state of the vertical scrolling 5) so as to maintain said horizontal scrolling during said rotation. Further, there is no motivation to combine the references. It is quite clear that “[t]he mere fact that prior art could be modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.” *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984)(reversing an obviousness rejection). In view of the foregoing, the combinations of the Leman, Solhjell, and Schnarel are legally improper. Hence, claims 5 and 17-18 are allowable.

The Office Action rejected dependent claim 11, and dependent claims 23 and 24 under a combination of Leman, Solhjell and U.S. Pat. No. 5,987,939 to Garvin. Claims 11, 23 and 24 pertain to, *inter alia*, a keyboard as recited comprising a user-selectable mode for scrolling or

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graphical point control is responsive to voice inputs. Claim 11 depends from claim 1 and claim 24 depends from claim 20 and both dependent claims pertain to the recited first input device, respectively; and claim 23 depends from claim 13 and pertains to the recited trackball device. Neither Leman, Solhjell, nor Gavin teach the recited first input device. In view of the foregoing, claim 11, 23 and 24 are allowable for these reason as well.

The Office Action rejected claim 12 under a combination of Leman, Solhjell and U.S. Pat. No. 5,374,942 to Gilligan et al. As applied to claim 1, neither Leman, nor Solhjell, nor Gilligan teach first recited input device. In view of the foregoing, claim 12 is allowable.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that this application is in condition for allowance. Should the Examiner believe that anything further is desirable in order to place the application in better form for allowance, the Examiner is respectfully urged to contact Applicant's undersigned representative at the below-listed number. If any additional fees are required or if an overpayment has been made, the Commissioner is authorized to charge or credit Deposit Account No. 19-0733.

Respectfully submitted,

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